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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/692,035 | 10/23/2003 | Akihiro Inomata | 0941.68545 | 6447 |

7590

07/01/2005

Patrick G. Burns
GREER, BURNS & CRAIN, LTD.
Suite 2500
300 South Wacker Drive
Chicago, IL 60606

EXAMINER

RICKMAN, HOLLY C

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,035

Applicant(s)

INOMATA, AKIHIRO

Examiner

Holly Rickman

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/05 has been entered.

2. It is noted that all rejections set forth in the last Office action have been withdrawn in view of Applicant's amendments.

Election/Restrictions

3. Newly submitted claim 25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 25 is directed to a method which is patentably distinct from the originally presented article claims. In the instant case, the article as claimed can be made by a materially different process than set forth in claim 25 and in addition, the search required for the method claim is not required for the article claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 17-20 and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7-8, 12 and 14 of U.S. Patent No. 6670057. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are an obvious variation of the invention set forth in US 6670057.

The aforementioned claims of US 6670057 include all of the limitations of the present invention except for the limitation in claim 17 directed to characteristics of the claimed recording medium when subjected to a magnetic recording process.

The examiner takes the position that the invention set forth in the claims of US 6670057 would inherently satisfy this limitation by virtue of the fact that it is structurally and compositionally the same as the presently claimed invention. Thus, one of ordinary skill in the art would expect it to exhibit the same properties when subjected to a magnetic recording process.

With respect to independent claim 24, US 6670057 claims a patterned medium having all of the limitations of this claim except for the head component. However, claim 14 of US 6670057 discloses a storage apparatus that includes a head and a magnetic recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to add a recording head to the medium set forth in claim 12 of US 6670057 in order to create a functional magnetic storage apparatus.

Allowable Subject Matter

6. The present claims are patentably distinct from the closest prior art to Carey et al. Carey et al. fail to teach or suggest the claim limitation directed to a recording medium having an exchange coupling field that is larger than both a coercivity Hc1 of a first magnetic layer and a coercivity Hc2 of a second magnetic layer.

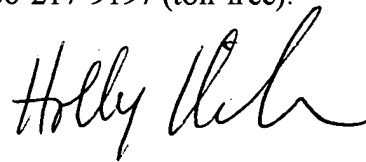
It is also noted that WO 02/13190 teaches an antiferromagnetically coupled recording medium but fails to teach or suggest the claim limitation directed to a recording medium having an exchange coupling field that is larger than both a coercivity Hc1 of a first magnetic layer and a coercivity Hc2 of a second magnetic layer. Neither Carey et al. nor WO 02/13190 inherently satisfy this claim limitation. As stated in the present specification, adjusting coercivity of magnetic layers is done by adjusting composition, additives and process steps. The aforementioned references fail to disclose combinations of first and second magnetic layers having suitable compositions/additives that would inherently satisfy the claimed coercivity/exchange coupling relationship.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Holly Rickman", with a stylized, cursive script.

Holly Rickman
Primary Examiner
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